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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/826,093	04/16/2004	James G. Sullivan		9256

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LAW OFFICE OF ADRIENNE B. NAUMANN
8210 NORTH TRIPP
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EXAMINER

LEE, JONG SUK

ART UNIT PAPER NUMBER

3673

DATE MAILED: 03/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/826,093

Applicant(s)

SULLIVAN, JAMES G.

Examiner

Jong-Suk (James) Lee

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 10, 14 and 16-21 is/are allowed.
- 6) ☒ Claim(s) 1-4, 6, 11-13 and 15 is/are rejected.
- 7) ☒ Claim(s) 5 and 7-9 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Specification

1. The disclosure is objected to because of the following informalities:

Page 1, 1st paragraph: -- This application is a continuation in part of U.S. Patent Application Serial No. 10/252,255 filed September 23, 2002, now U.S. Patent No. 6,746,183 -- should be placed under the subtitle, -- **CROSS REFERENCE TO RELATED APPLICATION** --.

Page 1, line 1: "BACKGROUND OF THE INVENTION" should be moved before "(1) My7 invention relates....." in line 15.

Appropriate correction is required.

Claim Objections

2. Claims 1, 2 and 10 are objected to because of the following informalities:

Claims 1 and 10, respectively: a capitalized letter of the first word in each sections in the body of the claim should be changed to the lower case letter.

Claim 1, line 17: "a abutting component" should be -- an abutting component --.

Claim 2, lines 1-2: "is a is a" should be -- is a --.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 9, 11 and 19-21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Re claim 9: The limitation, "said indentation walls" in line 1 lacks clear antecedent basis. It appears to be dependent upon claim 8 and has been treated as such.

Re claim 11: The limitation, "said outer ring" in lines 1-2 lacks clear antecedent basis. It is suggested to be -- said outer cam collar --.

Re claim 19: The limitation, "said cylinder end plug" in lines 1-2 lacks clear antecedent basis. It is suggested to be -- said cylindrical plug --. Claims 20-21 are dependent upon claim 19.

Appropriate correction is required.

Obviousness-Type Double Patenting

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686

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F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 1-4, 6, 9, 11-13 and 15 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4 of U.S. Patent No. 6,746,183.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the present claimed invention is somewhat broader than and different from '183 Patent in claim terminology, for example, in claim 1 of present claimed invention and claim 1 of '183 Patent, the Applicants claim:

“(A) a piston and a cylinder, said cylinder partially enclosing said piston, said piston and said cylinder each comprising an interior wall, said cylinder having a longitudinal axis and said piston having a longitudinal axis, said piston and said cylinder each comprising a distal end and a proximal end, said piston and said cylinder each comprising an exterior wall, each said piston and cylinder comprising an interior wall and a pre-determined wall thickness,

(B) at least one straight metal cam pin, and

(C) a mechanical device, said mechanical device encircling said piston and said cylinder,

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wherein said mechanical device comprises in combination,

(1) an outer cam collar, said outer cam collar comprising a penetrating component, said outer cam collar movably positioned along said longitudinal axis of said piston, said outer cam collar engaging said cylinder and said piston,

(2) an inner ring, said inner ring attached to and encircling said cylinder, said inner ring comprising a continuous circular indentation, said continuous circular indentation comprising an indentation floor, said inner ring further comprising a(n) abutting component,

said outer cam collar concentrically enclosing said inner ring,

whereby said outer cam collar is prevented from rotation by said penetrating component abutting said indentation floor,

whereby said piston is prevented from rotation by said penetrating component abutting said indentation floor through friction, and

whereby said abutting component abuts said piston and prevents said piston from becoming a projectile.”

whereas in ‘183 Patent, the Applicants claim,

“(A) a piston and a cylinder, said cylinder partially enclosing said piston, said piston and said cylinder each comprising an interior wall, said cylinder having and said piston both having a longitudinal axis, said piston and said cylinder each comprising an interior wall,

(B) a separately operable mechanical device, said mechanical device positioned along said piston and said cylinder for retention of said piston against rotation of said piston

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during an expanded condition, wherein said separately operable mechanical device comprises in combination,

(1) an outer ratcheting collar, said outer ratcheting collar comprising a lock member, said outer ratcheting collar movably positioned along said longitudinal axis of said piston, said

outer ratcheting collar engaging said cylinder and said piston,

(2) an inner ratcheting ring, said inner ratcheting ring fixedly encircling said distal end of said cylinder, said inner ratcheting ring comprising interlocking components, whereby said outer ratcheting collar engages said inner ratcheting ring, whereby said piston is prevented from rotation by said outer ratcheting collar and said inner ratcheting ring.”

(see col.17, lines 10-26; col.18, lines 1-10).

Therefore, in respect to above discussions, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the teachings of claims 1-4 of ‘183 Patent as a general teachings for a shoring device as claimed by the present application. The instant claims obviously encompass the claimed invention of ‘183 Patent and differ only in terminology. To the extent that the instant claims are broaden and therefore generic to the claimed invention of ‘904 Patent [species], In re Goodman 29 USPQ 2d 2010 CAFC 1993, states that a generic claim cannot be issued without a terminal disclaimer, if a species claim has been previously been claimed in a co-pending application.

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With respect to the material, such as aluminum, or aluminum type 6061-T6, an artisan within the ordinary skill in the art would have used the conventional aluminum or aluminum alloy material in order to produce the device with light weight.

Allowable Subject Matter

7. Claims 10, 14, 16-21 would be allowable over the prior art of record.
8. Claims 5 and 7-9 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims and **upon timely filing Terminal Disclaimer.**

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Other references disclose a support member for a floor beam of a building, a continuous adjustable rescue strut and a support strut.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jong-Suk (James) Lee whose telephone number is (703) 308-6777. The examiner can normally be reached on 6:30 am to 3:00 pm, Monday thru Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather C. Shackelford, can be reached on (703) 308-2978. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

J. Lee /jjl
March 15, 2005

A handwritten signature in black ink, appearing to read 'J. Lee' with a stylized flourish.

Jong-Suk (James) Lee
Primary Examiner
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